



Image

SEC.813

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

Sung-min YIM et al.

Group Art Unit: 2829

Serial No.: 09/955,310

Examiner: PATEL, Paresh H.

Filed: 19 February 2001

For: APPARATUS AND METHOD
FOR MEASURING ELECTRICAL
CHARACTERISTICS OF A
SEMICONDUCTOR ELEMENT IN A
PACKAGED SEMICONDUCTOR
DEVICE

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **Mail Stop Non-Fee Amendment**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

In response to the Office Action dated 10 February 2004, Applicants submit the following Traversal and Provisional Election.

TRAVERSAL

Applicants respectfully submit that the Office Action fails to meet the

requirements of M.P.E.P. §§ 803 and 808. To maintain a restriction requirement, M.P.E.P. § 808 requires that the Examiner: (1) provide reasons why the inventions as claimed are either independent or distinct; and (2) state the reasons for insisting upon restriction therebetween.

Regarding the first issue, Applicants note that the Office Action concedes that claims in Groups I and II are all drawn to a method of measuring electrical characteristics of an electrical element within semiconductor devices in a packaged state. They are not a related as combination/subcombination, and Applicants respectfully traverse the Examiner's statement that they are. Moreover, the claims of Groups I and III are all classified in the same class 324. Also, Applicants respectfully submit that the Examiner has failed to show that the method and apparatus of Groups I and III are distinct.

Applicants also submit that the Office Action has failed to state sufficient reasons for insisting upon the restriction, as required in the M.P.E.P.

Attention is respectfully drawn to M.P.E.P. § 803:

*"If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on its merits, even though it includes claims to independent or distinct inventions."*

(emphasis added). In this regard, Applicants note that Groups I and III of the claims admittedly are drawn to invention(s) within the same class 324. Furthermore, the Examiner has already searched and examined claims from each of the three declared groups I, II and III in **two prior Office Actions** dated 20 February 2003 and 4 September 2003.

Therefore, Applicants respectfully submit that no serious burden is presented to examine all of the claims of the pending application, and accordingly, it is respectfully submitted that restriction is improper.

Furthermore, M.P.E.P. § 808 provides the three proper reasons for insisting upon restriction. All three of these reasons pertain to the classification and field of search of the claims. The Office Action admits that Groups I and III belong to the same class (although with slightly varying subclasses).

The Office Action has not stated that restriction is being insisted upon because the declared groups have acquired a separate status in the art. M.P.E.P. § 808 (B) provides that separate status in the art may be shown by citing patents which are evidence of separate status, and also of a separate field of search. However, the Office Action failed to cite any patents or to state anything at all regarding the field of search for the declared groups. Instead, the Office Action stated that the declared groups have acquired separate status in the art supposedly “because of their recognized divergent subject matter.”

Applicants respectfully do not recognize any divergent subject matter. Applicants also do not see in the Office Action any facts in support of this assertion of “recognized divergent subject matter.” Furthermore, Applicants respectfully do not see anything in the M.P.E.P. that indicates that such a bare assertion can form the basis for maintaining that a separate status in the art exists, and ultimately, that the restriction requirement must be insisted upon. More importantly, Applicants respectfully see nothing in the M.P.E.P. that indicates that such a bare assertion can overcome the heavy burden imposed by M.P.E.P. § 803, cited above, especially where as here, the claim groups have already been searched and examined.

Accordingly, for at least these reasons, the restriction requirement in this case is respectfully traversed and it is requested that it be withdrawn.

PROVISIONAL ELECTION

Although Applicants traverse the restriction requirement, as required by rule Applicants hereby provisionally elect Group I, consisting of claims 1-3, 5-14 and 18 drawn to an apparatus that measures electrical characteristic of an electrical element within semiconductor devices in a packaged state, for further prosecution in this case, should the restriction requirement ultimately be maintained despite Applicants’ traversal.

CONCLUSION


In view of the preceding remarks, Applicants respectfully request that the Examiner reexamine and reconsider the present application, allow claims 1-19 and pass the application to issue.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future Amendments and replies to charge payment or credit any overpayment to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

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Date: 10 March 2004

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